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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,744	04/20/2004	Tracy E. Grim	Royce-66794	5476

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FULWIDER PATTON LEE & UTECHT, LLP  
Attention : Alan C. Rose  
Howard Hughes Center, Tenth Floor  
6060 Center Drive  
Los Angeles, CA 90045

EXAMINER
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PETRIK, KARI KRISTEN

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/828,744

Applicant(s)

GRIM ET AL.

Examiner

Kari Petrik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 11-13, 16, 22-24, 27 and 30-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-10, 14, 15, 17-21, 25, 26, 28, 29, 40-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group 2 species 1 is acknowledged. The traversal is on the ground(s) that the rationale for restriction between the process and apparatus claims is invalid. This is not found persuasive because activating the hardenable material before applying the splint to the patient and activating the hardenable material while the splint is secured to the patient would be different methods of applying the splints. In addition, the product as claimed could be applied by a different method, such as by engaging the primary tacking arrangements so that they are tightly secured and do not allow adjustment of the splint. The requirement is still deemed proper and is therefore made FINAL.
2. The traversal is on the ground(s) that withdrawn apparatus claims 6 and 25 and are generic claims and they should be examined. This is found persuasive, and claims 6-10, 14, 15, 17-21, 25-26, 28, 29, and 40-47 are being examined as reading on the elected species.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 6-9, 14, 18, 20, 21, 25, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Darcey (US Patent 6,106,492).
5. Regarding claim 6, Darcey discloses a splint comprising: an elongated blank (14) impregnated with hardenable material, primary tacking arrangements (26) which are inherently capable of holding the blank in place to allow adjustment of the blank, and secondary holding arrangements for functionally securing the blank (Figure 11) whereby the splint can be easily and properly mounted.
6. Regarding claim 7, the blank is of longitudinal extent and has laterally extending extensions creating the tacking arrangements (Figure 9).
7. Regarding claims 8 and 9, the blank has a covering of hook receivable material (16) and the primary tacking arrangements are provided with a hook and loop type construction (32 and 28).
8. Regarding claim 14, the secondary holding arrangements comprise an exo-skeletal structure overlying the blank.
9. Regarding claim 18, the primary tacking arrangements are removable and repositionable with respect to the splint.
10. Regarding claim 20, the blank has a padding layer on at least one side (20).
11. Regarding claim 21, the secondary holding arrangements include a resilient, flexible, stretchable tape (34).
12. Regarding claim 25, note the rejection of claim 6.
13. Regarding claim 26, note the rejection of claim 8.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darcey.

16. Regarding claim 17, Darcey substantially discloses the claimed invention as applied to claim 6, but does not disclose that the primary tacking arrangements are made of a nonwoven material. However, a thorough reading of the specification provides no criticality to the materials making up the tacking arrangements. At the time the invention was made, it would have been an obvious matter of design choice to one of ordinary skill in the art to have made the tacking arrangements of nonwoven material or any other selected material, because Applicant has not disclosed that such a material provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Darcey's splint and Applicant's invention to perform equally well with either the material used by Darcey, or the claimed nonwoven material because both materials would perform the same function of holding the blank in place. Therefore, it would have been *prima facie* obvious to modify Darcey to obtain the invention as specified in the claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art.

17. Claims 19, 40-42, 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darcey (US Patent 6,106,492) in view of Parker et al. (US Patent 5,755,678).

18. Regarding claim 19, Darcey substantially discloses the claimed invention as applied to claim 6, but does not specify that the primary tacking arrangements are made of a stretchable material. However, Parker et al teaches the use of an elastic strap (124) to hold the splint onto the body. It would have been obvious to one skilled in the art at the time the invention was made to have provided the splint disclosed by Darcey wherein the primary tacking arrangements are of an elastic material, as taught by Parker et al., to provide more comfort to the user.

19. Regarding claims 40-42, 44, and 46, Darcey discloses a splint comprising: an elongated blank (14) impregnated with hardenable material, at least one layer of additional non-impregnated material on at least one side of the blank (20), laterally extending primary tacking arrangements (26), and secondary holding arrangements for functionally securing the blank (Figure 11). The additional layer is a padding material (column 5, lines 59-65). One side of the blank is covered with a padding material (20) and the other with a hook receivable material (16, fabric is a hook receivable material) and the primary tacking arrangements are provided with a hook type construction thereon (32). The hook receivable material is UBL fabric (16), and the blank is formed of multiple layers of casting material (24). Darcey does not disclose a blank that is in roll form.

Parker et al. disclose a splint comprising: an elongate blank (10) in roll form (Figure 1) impregnated with a hardenable material, at least one layer of additional non-impregnated material (18), and secondary holding arrangements (Figure 10) for functionally securing the blank in place. The additional layer is a padding material (column 7, lines 37-42), and said blank is formed of multiple layers of casting material (16). Parker et al. specify that the splint be in roll form so that it can be dispensed in used-determined lengths suitable for any given medical use.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the splint disclosed by Darcey wherein the blank is in roll form, as taught by Parker et al., so that it can be dispensed in used-determined lengths suitable for any given medical use.

20. Claims 10, 15, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darcey in view of Grim et al (US Patent 6,139,513).

21. Darcey in view of Parker et al. substantially disclose the claimed invention as applied to claims 6 and 25. Darcey does not disclose a splint wherein the blank is formed of double knit spacer material, and the tacking arrangements are non-rectangular in shape.

Grim et al. disclose a splint comprising an elongated blank with hardenable material (202), at least one layer of additional non-impregnated material (30 and 32), and laterally extending primary tacking arrangements for holding said blank in place (204). Grim et al. further disclose a splint wherein a the blank is formed of double knit

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spacer material (28), and the tacking arrangements are non-rectangular in shape (204). Grim et al. specify that the use of double knit type material improve the control of the flow of water to the curable resin and provide desired strength for the product.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the splint disclosed by Darcey in view of Parker et al. having padding material of double knit fabric, a blank of double knit spacer material, and tacking arrangements non-rectangular in shape, as taught by Grim et al., to improve the control of the flow of water to the curable resin and provide desired strength for the product.

22. Claims 43, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darcey (US Patent 6,106,492) in view of Parker et al. (US Patent 5,755,678) as applied to claim 40 above, and further in view of Grim et al. (US Patent 6,139,513).

Darcey in view of Parker et al. disclose the claimed invention as applied to claim 40. Darcey does not disclose a splint wherein the padding material is a double knit fabric, the blank is formed of double knit spacer material, and the tacking arrangements are non-rectangular in shape.

Grim et al. disclose a splint comprising an elongated blank with hardenable material (202), at least one layer of additional non-impregnated material (30 and 32), and laterally extending primary tacking arrangements for holding said blank in place (204). Grim et al. further disclose a splint wherein a padding material is a double knit



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fabric (24 and 26), the blank is formed of double knit spacer material (28), and the tacking arrangements are non-rectangular in shape (204). Grim et al. specify that the use of double knit type material improve the control of the flow of water to the curable resin and provide desired strength for the product.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the splint disclosed by Darcey in view of Parker et al. having padding material of double knit fabric, a blank of double knit spacer material, and tacking arrangements non-rectangular in shape, as taught by Grim et al., to improve the control of the flow of water to the curable resin and provide desired strength for the product.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kari Petrik whose telephone number is 571-272-8057. The examiner can normally be reached on M-Th 7-4:30.

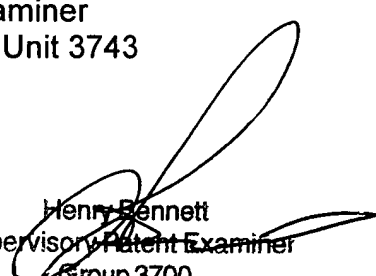
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kari Petrik  
Examiner  
Art Unit 3743

KKP



Henry Bennett  
Supervisory Patent Examiner  
Group 3700